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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,782	05/26/2005	Jorgen Rasmussen	PATRADE	6076
49801	7590	01/28/2009	EXAMINER	
JAMES C. WRAY 1493 CHAIN BRIDGE ROAD SUITE 300 MCLEAN, VA 22101			OSTRUP, CLINTON T	
			ART UNIT	PAPER NUMBER
			3771	
			MAIL DATE	DELIVERY MODE
			01/28/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/533,782

**Applicant(s)**

RASMUSSEN ET AL.

**Examiner**

CLINTON OSTRUP

**Art Unit**

3771

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 January 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: 5, 9 and 14-16  
Claim(s) rejected: 1-4, 6-8 and 10-13  
Claim(s) withdrawn from consideration: \_\_\_\_\_

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/Justine R Yu/  
Supervisory Patent Examiner, Art Unit 3771

/Clinton Ostrup/  
Examiner, Art Unit 3771

Continuation of 3. NOTE: The amendment to claim 3 wherein the cap has been changed from an "open" position to a "closed" position would require further consideration and/or search.

Continuation of 11. does NOT place the application in condition for allowance because: It does not obviate the objections and rejections noted below and in the final Office Action mailed 10/7/08.

In response to applicant's request to defer the requirement for formal drawings until allowance, it was noted in the Final Rejection mailed 10/7/08, that formal drawings in compliance with 37 CFR 1.121(d) are required and that "the objection will not be held in abeyance." Thus, the requirement for formal drawings will not be held in abeyance until the application is in condition for allowance.

The new matter rejection is proper and has been maintained because although a dose counting mechanism was described in the claims, it was not described with the level of detail and complexity as presented in the amendment filed 7/7/08.

Regarding the rejection of claim 4, it has been rejected under 35 USC 112, first paragraph as containing new matter, as it contains claimed subject matter which was not described in the specification as originally filed.

Regarding applicant's inquiry to the indication of allowability of claims 4, 5, 9 & 14-16, claims 4 and 5 are free of art but are either directly or indirectly rejected as containing new matter. However, claims 9 and 14-16 are free art but are objected to as depending from rejected base claims.

The examiner has noted applicant's objection to the use of their own citations. However, the examiner contends that the statements are correct. Dose counting mechanisms are generally interchangeable with minor modifications and it is also known to use dose counting mechanisms in these types of devices.

Applicant's arguments to the 35 U.S.C. 103(a) rejection has not been found convincing. Applicant argues that Brauna does not teach or suggest yoke means for transferring movement to a dose counting mechanism arranged in the housing; however, the rejection is based upon a combination of Brauna and Rand. Brauna discloses a lever which causes movement of a yoke and Rand teaches a dose counter mechanism and as described above, it is known in the art to incorporate dose counting devices in these types of devices and dose counting mechanisms are generally interchangeable with minor mechanical modifications.

Applicant's argument regarding claim 3 is confusing because they are arguing the cap in its open configuration and presenting a proposed amended claim 3 with the cap in its closed configuration. For purposes of appeal and examination, the claim was read as previously presented with the cap in an open configuration and this claim has been rejected as containing new matter.

Regarding applicant's argument of claim 6, that Brauna does not teach the lever arm and cap as claimed, the lever of Brauna has a portion 6b in figure 1 that is flush with or contained in the housing when the cap is closed (figure 1) and projects from the housing when the cap 6 is open (figure 2).